

REMARKS/ARGUMENTS

Applicants respectfully request further examination and consideration in view of the arguments set forth fully below. Prior to this Office Action, Claims 1-49 were pending in this application. Claims 1-49 stand rejected in a non-final Office Action under 35 U.S.C. §103(a). In this Response, claims 1-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-49 were amended and claims 5, 11, 14, 22, 24-26, 31-33, 37-39, and 42 were canceled. Claims 50 and 51 are new claims. No new matter was added in this paper. Accordingly, claims 1-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 are currently pending in this application.

CLAIM REJECTIONS UNDER 35 U.S.C §103(a)

Within the Office Action, Claims 1-49 are rejected under § 103(a) as being obvious over U.S. Patent No. 5,819,285 (filing date: September 20, 1995) to Damico et al (hereinafter "Damico"). Applicants respectfully traverse this basis for rejection.

Damico discloses an apparatus for capturing a co-marketer identity, where the co-marketer has referred a user on a user station to an online computer service (OLS). [Abstract]

Within the Office Action, on page 3, it is stated that:

With respect to the recommendation message being sent by e-mail and performing certain forwarding procedures. . . Damico is silent as to the form of transmission of the first message but since Damico uses [sic] is On-line, Internet based system it would have been obvious to have had e-mail to receive and send messages to an individual or group and to forward messages. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the recommendation message being sent by e-mail in order to achieve the above mentioned advantages.

Applicants respectfully disagree.

Damico does not teach all the claimed limitations of the independent claim 1. The independent claim 1 is directed to a method of marketing comprising the steps of: a.) offering a

reward to a first party in exchange for a recommendation of a marketable entity, the recommendation comprising a forwarding of a first e-mail message to a second party, the first e-mail message comprising a personalized referral for the marketable entity and a first set of data, the first set of data comprising a first serial number and a first URL link to a first Web site
5 having an offer to transact for the marketable entity; b.) correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data relating to the reward offered to the first party; c.) updating the database with an e-mail address of a second party provided by the first party; and d.) forwarding the first e-mail message to the e-mail
10 address of the second party, wherein the marketable entity is selected from a group consisting of goods and services.

As to claim 1, Damico does not disclose, teach or suggest the limitations of “updating the database with an e-mail address of a second party provided by the first party” or “forwarding the first e-mail message to the e-mail address of the second party.” Instead, Damico requires that a co-marketer provide user software 106a to a user for installation onto the user station 102a. The
15 user software 106a can be provided through a floppy disk, a CD-ROM disk, magnetic tape, or through a FTP site on the Internet. The user software 106a includes an embedded co-marketer symbol or code which can be recognized by the OLS 140 when the user connects to the OLS 140 through a Web site 128 associated with the OLS 140. [col. 4, lines 62-67 and col. 5, lines 1-67]

In Damico, a user station 102a is initially coupled to a site 122a of a first co-marketer on
20 the WWW 120. The site 122a can have an advertisement for the OLS 140, such that the user of the user station 102 may connect to the OLS site 128 by clicking on the advertisement. Once the user clicks on the advertisement at the WWW site 122a, the WWW site 122a forms a special destination URL having two parts, the first part for the URL associated with the OLS site 128 and the second part having both the destination file name and a UNIX symbolic link prepended
25 by the co-marketer associated with WWW site 122a. [col. 5, lines 25-55]

It would not have been obvious to add the features of e-mail messages and e-mail forwarding to Damico, since Damico requires the user at the user station 102a to first visit a WWW site 122a having an advertisement of the OLS site 128, so that the user may click on the advertisement for the apparatus and method in Damico to operate. Once the user clicks on the advertisement, then the capturing of the co-marketer's identity can be determined in Damico from the co-marketer symbol found in the special destination URL. Hence, the apparatus and method of Damico can only work through a user accessing multiple Web sites, including a co-marketer's Web site and the Web site of the online service.

Further, Damico does not teach updating of a database to include the e-mail address of the second party, where the e-mail address of the second party is provided by the first party. Damico also does not teach the forwarding of the first e-mail message to the e-mail address of the second party. Instead, Damico describes a method and apparatus for tracking the navigation path of a user that has been directed from a first Web site to a second Web site, through clicking advertisements on Web sites associated with the OLS [col. 2, lines 61-67]. Damico does not use personalized e-mail referrals, so anyone can click on the advertisement banner for the OLS. Therefore, unlike the present invention, the apparatus and method of Damico are vulnerable to hacking and abuse by unwanted users.

In contrast, the present invention teaches a method of marketing that allows for personalized e-mail referrals that include serial numbers and URL links to a Web site having an offer to transact for the marketable entity. Also, the method includes the step of updating a database to include the e-mail address of the second party, where the e-mail address of the second party is provided by the first party. Thus, unlike Damico, the present invention is fortified from hacking and abuse. Also, the present invention allows for targeted marketing and does not allow for everyone to access the first Web site. The first Web site can only be accessed through the first e-mail message, which includes a first serial number and a first URL link to the

first Web site. Also, the method includes the step of forwarding of the first e-mail message to the e-mail address of the second party.

For at least these reasons, Claim 1 is allowable over Damico. Claims 2-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-45 depend from independent claim 1, an allowable base claim. Thus, for at least these reasons, Claims 1-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-45 are in condition for allowance.

The independent claim 46 is directed to a method of marketing comprising the steps of:
a.) transacting for a first marketable entity by a first party; b.) offering a reward to the first party in exchange for a recommendation of a second marketable entity substantially similar to the first marketable entity to a second party wherein the recommendation results in a transaction; and c.) forwarding an e-mail to a second party, the e-mail comprising the recommendation for the second marketable entity by the first party, an e-mail address of the first party, and a URL link to a Web site having an offer to transact for the second marketable entity, wherein the first marketable entity and the second marketable entity are selected from a group consisting of goods and services.

Damico does not teach, suggest, or disclose “forwarding an e-mail to a second party, the e-mail comprising the recommendation for the second marketable entity by the first party, an e-mail address of the first party, and a URL link to a Web site having an offer to transact for the second marketable entity.” Instead, Damico describes a method of capturing a co-marketer’s identity based on the navigation path taken by a user who later subscribes to an online service, where the user has been redirected to the Web site of the online service through an advertisement on the co-marketer’s Web site.

In contrast, the present invention has at least two advantages over Damico. First, the invention encourages the second party to read the e-mail having the recommendation by the first, since the e-mail includes the recommendation, the e-mail address belonging to the first party, and

a URL link to a Web site. Second, unlike Damico, the present invention does not require referring parties to have Web sites hosting advertisements for marketable entities. Instead, the present invention advantageously uses e-mail to simultaneously track recommendations and encourage transactions of the marketable entity, based on trusted recommendations.

5 For at least these reasons Claim 46 is allowable over Damico. Claim 47-49 depend from independent claim 46, an allowable base claim. Thus, for at least these reasons, Claims 46-49 are in condition for allowance.

New Claims 50-51

10 The independent claim 50 is directed to a system for marketing comprising: a.) means for accessing a database configured for storing data; b.) a computer operatively coupled to the database, the computer configured to provide access to the Web; c.) means for offering a reward to a first party in exchange for a recommendation of a marketable entity, the recommendation comprising a forwarding of a first e-mail message to a second party, the first e-mail message
15 comprising a personalized referral for the marketable entity and a first set of data, the first set of data comprising a first serial number and a first URL link to a first Web site having an offer to transact for the marketable entity; d.) means for correlating the first set of data in the first e-mail message to data within the database, the data within the database comprising data relating to the reward offered to the first party; e.) means for updating the database with an e-mail address of
20 the second party provided by the first party; and f.) means for forwarding the first e-mail message to the e-mail address of the second party, wherein the marketable entity is selected from a group consisting of goods and services.

 Damico does not teach, suggest or disclose “means for updating the database with an e-mail address of the second party provided by the first party.” Further, Damico does not teach,
25 suggest, or disclose “means for forwarding the first e-mail message to the e-mail address of the

second party.” Instead, in Damico, advertisements on Web sites of co-marketers can be clicked on by anyone to obtain access to the Web site of the online service.

In contrast, the system of the present invention is more fortified from hacking and other forms of abuse from unwanted users, since the system provides means for forwarding
5 personalized e-mail referrals that include serial numbers and URL links to a Web site having an offer to transact for the marketable entity. Thus, the present invention is resistant to hacking and other forms of interference from external sources. Also, the system includes a means for updating
a database to include the e-mail address of the second party, where the e-mail address of the second party is provided by the first party. Further, the present invention allows for marketing
10 that is targeted. Not everyone can access the first Web site. The first Web site can only be accessed via the first e-mail message, which includes a first serial number and a first URL link to the first Web site.

For at least these reasons Claim 50 is allowable over Damico. Claim 51 depends from independent claim 50, an allowable base claim. Thus, for at least these reasons, Claims 50 and
15 51 are in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes that a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact the undersigned at (408) 530-9700.

Respectfully submitted,

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CERTIFICATE OF MAILING (37 CFR § 1.6(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

HAVERSTOCK & OWENS LLP.

Date: 2/23/06 By: [Signature]